

REMARKS

This Amendment is submitted in response to the Office Action dated July 30, 2003. In the Office Action, the Patent Office rejected Claim 9 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Patent Office also rejected Claim 9 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly claim the subject matter which applicant regards as the invention. Further, the Patent Office rejected Claims 8 and 11 under 35 U.S.C. §102(b) as being clearly anticipated by *Haney et al.* ('944). Finally, the Patent Office rejected Claims 9, 10 and 12 under 35 U.S.C. §103(a) as being unpatentable over *Haney* in view of *Biewen*.

By the present Amendment, Applicant amended Claims 8 and cancelled Claim 9. Applicants submit that the amended claim overcome the rejections made by the Patent Office and place the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claim 9 under 1-25 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. More specifically, the Patent Office asserts that the claim contains subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Patent Office states that there is no original disclosure directed to "Tinosan AM110, a product of Ciba...Corporation." In response to the rejection, Applicant has cancelled Claim 9. With the cancellation of

Claim 9, applicant respectfully submits that the rejection under 35 U.S.C. §112, first paragraph, has been traversed. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claim 9 under 1-25 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Patent Office states that the scope of the claim is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In response to the rejection, Applicant has cancelled Claim 9. With the cancellation of Claim 9, applicant respectfully submits that the rejection under 35 U.S.C. §112, second paragraph, has been traversed. Notice to that effect is requested.

In the Office Action, Claims 8 and 11 were rejected under 35 U.S.C. §102 as being clearly anticipated by *Haney et al.* ('944). The Patent Office alleges that the term frothed is considered a process limitation that does not structurally distinguish the claimed article over the foam layer in the reference's article. Also the phrase "comprised of" does not preclude the presence of more than one layer of laminate.

Amended Claim 8 requires a disposable floor mat for restroom floors and other high-maintenance areas requiring sanitation. Claim 8 requires that the mat be comprised of a flat face layer and flat underlayer, the face layer fixedly attached to the underlayer. Amended Claim 8 also requires that the entire mat be completely disposable, the face layer made of non-woven, absorbent polypropylene. Further,

Claim 8 requires that the underlayer be made of non-absorbent, moisture resistant frothed plastic foam. Moreover, Claim 8 requires the face layer having an anti-microbial agent contained thereon. Further, amended Claim 8 also requires that the underlayer be comprised of a sticky material that is removable from a substantially flat surface.

On the contrary, *Haney et al.* teaches a disposable multi-purpose absorbent pad that has a top layer of absorbent material, a second layer of absorbent material and a third layer of impermeable material, the layers being joined at the edges of the pad forming a peripheral seal.

However, *Haney et al.* do not teach or suggest a disposable floor mat for restroom floors and other high-maintenance areas requiring sanitation wherein the mat be completely disposable and further wherein the face layer is made of non-woven, absorbent polypropylene. Moreover, *Haney et al.* do not teach an underlayer made of non-absorbent, moisture resistant frothed plastic foam wherein the underlayer is comprised of a sticky material that is removable from a substantially flat surface. Further, *Haney et al.* do not teach or suggest the face layer has an anti-microbial agent contained thereon.

Anticipation requires that a single reference discloses each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986).

Moreover, anticipation is not shown even if the differences

between the claims and the reference are "insubstantial" and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d 707, 716 223 USPO 1264, 1270 (Fed. Cir. 1984).

Applicant respectfully submits that amended Claim 8 distinctly defines the present invention from *Haney et al.* Applicant submit the amendments to Claim 8 along with the above remarks overcome the rejection, and that Claims 8, 10-12 are now in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 9,10 and 12 under 35 U.S.C. §103(a) as being unpatentable over *Haney et al.* in view of *Biewen*. The Patent Office alleges that *Haney et al.* discloses the invention substantially as claimed, but does not disclose the use of an antimicrobial agent on the mat or the claimed shape of the mat. The Patent Office alleges that *Biewen* discloses the use of an antimicrobial agent on floor mats and also discloses the claimed shape of the floor mat. The Patent Office states that it would have been obvious to one of ordinary skill in the art to vary the shape of the mat and include a notch on one side.

However, neither *Haney et al.* nor *Biewen*, taken alone or in combination, teach a disposable floor mat for restroom floors and other high-maintenance areas requiring sanitation having a mat comprised of a flat face layer and flat underlayer, the face layer fixedly attached to the underlayer, the entire mat completely disposable, the face layer made of non-woven, absorbent polypropelene,

the underlayer made of non-absorbent, moisture resistant frothed plastic foam. Moreover, neither *Haney et al.* nor *Biewen* taken alone or in combination, teach a disposable floor mat that has a face layer having an anti-microbial agent contained thereon and an underlayer comprised of a sticky material that is removable from a substantially flat surface.

Applicants respectfully submit that amended Claim 8 distinctly defines the present invention from *Haney et al.* and/or *Biewen*, taken singly or in combination. Applicants submit the amendment to Claim 8 along with the above remarks overcome the rejection, and that Claims 8,10-12 are now in condition for allowance. Notice to that effect is requested.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the reference in its entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of

Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

In view of the foregoing remarks and amendments, Applicants respectfully submit, the rejection under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 10-12 depend from Claim 8. Moreover, newly added Claims 12-18 depend from Claim 8. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional elements of Applicant's invention, for a disposable floor mat.

In view of the foregoing remarks and amendments, Applicant respectfully submits that the drawings, and the Claim in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so

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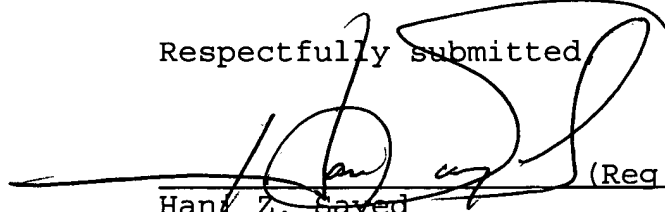
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that the same may be resolved and the application expedited the issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted



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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 10, 2003.



Valeina Jack